# REMARKS

Claim 6 has been amended. No claims have been added or cancelled. Claims 1-24, 51-73, 100-117, 136 and 138 are pending in the application. Reconsideration is respectfully requested in light of the following remarks.

## Double Patenting Rejection:

The Examiner rejected claims 1-24, 51-73, 100-117, 136 and 138 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-45 of U.S. Patent No. 6,868,447. Applicants traverse this rejection for the following reasons. The Examiner notes the claims of U.S. Patent No. 6,868,447 do not include the limitations in regard to bridging and proxy service as recited in the claims of the present application. The Examiner contends that these limitations were well known and would be obvious. The Examiner refers to the Tuatini reference for support of this contention. Applicants traverse the Examiner's assertion that these limitations were well known in the context of Applicants' claimed invention. The Examiner's reliance on Tuatini is misplaced as discussed below in Applicants' traversal of the prior art rejections. Therefore, the Examiner's double patenting rejection is not supported by the cited art.

## Claim Objection:

The Examiner objected to claim 6 because of informalities in the language of claim 6. Specifically, the Examiner objected to the fact that claim 6 referred to the "method as recited in 3" rather than the "method as recited in claim 3". Applicants have amended claim 6 as suggested by the Examiner to overcome the Examiner's objection.

## Benefit of Priority:

The Examiner contends that certain claim limitations (e.g. use of message passing model, a second device using a different message passing model, a proxy service generating a results advertisement, publishing an advertisement, generation of a results method gate from a results advertisement, and results advertisements being sent to a client method gate) are not disclosed in the provisional applications to which the instant application claims the benefit of priority. Applicants respectfully disagree with the Examiner and submit that claims of the current application are disclosed in each of the provisional applications (Serial No: 60/202,975, 60/208,011, 60/209,430, 60/209,140, 60/209,525) to which the instant application claims the benefit of priority.

Applicants note that the <u>Examiner has the burden</u> to present <u>evidence or reasons</u> why persons skilled in the art would not recognize support for applicants' claims in the provisional applications. *In re Wertheim*, 191 USPQ 90 (CCPA 1976). As stated by the Board of Patent Appeals & Interferences in *Ex parte Sorenson*, 3 USPQ2d 1462, 1463 (B.P.A.I. 1987), "a bare assertion by the Examiner" is insufficient for an assertion that a claim lacks support." The Examiner has not presented any *reasons or evidence* as to why persons skilled in the art would not recognize support for the current claims in the provisional applications to which the instant application claims the benefit of priority. Instead, the Examiner has merely made a bare assertion that certain claim limitations are not disclosed in the provisional applications (see, Action dated July 11, 2005, page 5, lines 3-9). As clearly stated by the Board of Patent Appeals & Interferences, such bare assertions are insufficient to establish a lack of support in the priority documents.

Moreover, Applicants note that the subject matter recited in the claims of the current application is supported in each of the provisional applications (Serial No: 60/202,975, 60/208,011, 60/209,430, 60/209,140, 60/209,525) to which the instant application claims the benefit of priority. For instance, the use of a message passing model (which the Examiner specifically asserts is not disclosed) is plainly described at length in provisional application 60/202,975. In fact, virtually the entire provisional

application 60/202,975 describes a message passing model for communicating in a distributed computing environment. Pages 15-18 of the 60/202,975 provisional application provides an introduction to using a message passing model in a distributed computing environment. Additionally, page 17, lines 14-26 states, "the foundation for the distributed computing environment is a simple message passing layer implemented on top of reliable connection and/or unreliable data grams" and goes on to describe how a message passing layer may support an "asynchronous, stateless style of distributed programming" and may be "based on a data representation language, such as XML." Even a cursory reading of the 60/202,975 provisional application reveals support for a use of a message passing model, in contrast to the Examiner's assertion. Support for the other limitations noted by the Examiner is also readily found in the 60/202,975 provisional application.

In response to Applicants' previous arguments regarding support in provisional application 60/202,975, the Examiner argues that the subject matter disclosed in provisional application 60/202,975 has a different scope than applicants' claims and specifically refers to "environments using different protocols" having a different scope than "different message passing models". However, provisional application 60/202,975 repeatedly refers to various protocols, such as TCP/IP, UDP/IP, J2ME, Bluetooth, RMI, etc, which encompass various and different message passing models. Furthermore, the Examiner refers to Applicants' claims as reciting, "different message passing models". However, Applicants' claims do not recite "different message passing models". Instead, applicants' claims recite one computing environment based upon a message passing model and another computing environment *not based upon* the message passing model. For example, claim 51 recites, in part, "a first device in a first computing environment based upon a message passing model" and "a second device in a second computing environment not based upon the message passing model of the first environment." Thus, not only does provisional application 60/202,975 provide support for different message passing models, the claims of the present application only require one computing environment based upon a message passing model and another computing environment not based on that message passing model. This is plainly described in the provisional

application. The Examiner's assertion regarding "environments using different protocols" having a different scope than "different message passing models" is irrelevant to the present application's claim to benefit of priority since these phrases are not used in the claims.

The Examiner also contends that the provisional applications to which the present invention claims benefit of priority do not include support for other limitations of applicants claims, such as generating results advertisement, publishing the advertisement, generating a results method gate, sending the results advertisement to a client method gate, and the proxy service appears to the first entity as the second entity. However, support for these limitations is included in each of the provisional applications to which the present invention claims benefit of priority (see, e.g., provisional application 60/202,975, page 39, line 13 – page 40, line 2; page 21, lines 9-26; page 23, lines 2 – 16; page 24, lines 5 – 28; page 25, line 22 – page 26, line 3; page 28, line 27 – page 29, line 4; page 29, line 6 – page 30, line 9; page 34, lines 5 – 25; page 37, line 25 – page 39, line 23).

Furthermore, 35 U.S.C. § 119(e) only requires that the claims be supported "in the manner provided by the first paragraph of section 112." It is well settled law that satisfaction of the requirements of the first paragraph of section 112 "does not require *in haec verba* antecedence in the originally filed application." *Staehelin v. Secher*, 24 USPQ 2d 1513, 1519 (B.P.A.I. 1992). It is also well settled law that the provisional "specification may, within the meaning of 35 U.S.C. § 112 ¶1, contain a written description of a broadly claimed invention without describing all species that claim encompasses." *Utter v. Hiraga*, 845 F.2d 993, 998, 6 USPQ 2d 1709, 1714 (Fed. Cir. 1988). Moreover, the section 112 requirements may be satisfied by principles of inherency. *In re Reynolds*, 443 F.2d 384 (CCPA 1971). The subject matter of a claim need not be described literally in order for the disclosure to satisfy the description requirement for a priority claim. As repeatedly stated by the Board of Patent Appeals & Interferences and by the Court of Appeals for the Federal Circuit, it is well settled law that the invention claimed [in the later application] does not have to be described [in the

parent] *in ipsis verbis* in order to satisfy the requirements of §112. *Jacobs v. Lawson*, 214 USPQ 907, 910 (B.P.A.I. 1982). The Examiner's assertion of lack of support in the provisional applications is "yet another instance of the sort of 'hypertechnical application' of the written description requirement of §112" that has been repeatedly criticized by the court. *In re Driscoll*, 195 USPQ 434, 438 (C.C.P.A. 1977); *In re Johnson*, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977); *Engineering Development Laboratories v. Radio Corp. of America*, 68 USPQ 238, 241-42 (2d Cir. 1946).

When considered as a whole, the description and drawings in each of Applicants' provisional applications (Serial No: 60/202,975, 60/208,011, 60/209,430, 60/209,140, 60/209,525) clearly supports the claims of the present application as required by the first paragraph of section 112. Applicants therefore assert that the present application is entitled to the claimed benefit of priority.

## Section 102(b) Rejection:

The Examiner rejected claim 138 under 35 U.S.C. § 102(b) as being anticipated by Tuatini (U.S. Publication 2002/0032783). Applicants respectfully traverse this rejection for at least the following reasons.

Regarding claim 138, Tuatini does not disclose <u>the proxy service</u> providing to the first entity an interface to a second entity in the second computing environment, wherein providing an interface comprises <u>sending to the first entity a schema defining one or more messages</u> in the data representation language for accessing the second entity, in contrast to the Examiner's contention.

The Examiner cites paragraphs [0166-0168] where Tuatini describes the use of an LDAP directory service. However, Tuatini does not teach sending a client application (which the examiner equates to a first entity) a schema defining one or more messages in the data representation language for accessing the second entity. Instead, Tuatini describes how a LDAP directory may include a schema defining object classes of

information that can be stored in the directory entries. Tuatini does not mention anything about a schema defining messages in a data representation language for accessing the LDAP directory service. Tuatini also fails to mention sending such a schema to the client application.

Furthermore, Tuatini teaches how a client accesses a LDAP directory by instantiating a directory manager object and uses method of the directory manager object to retrieve other objects (both directory entry objects and adapter objects) for accessing particular directory entries. (Tuatini, paragraph [0167]). Thus, Tuatini's system provides access objects for the entries of a LDAP directory service rather than sending a schema defining messages in a data representation language for accessing the directory service.

The Examiner also cites paragraphs [0122-0130] where Tuatini describes the use of a XML document type definition (DTD) to specify message parameters used to request service functions. However, the cited passage does not mention a proxy service sending the XML DTD to a client component, which is required by Applicants' claim 138. Instead, Tuatini describes that the XML DTD may be a part of a group of information for each shared service providing functionality to clients and that the information is "made available to others" (Tuatini, paragraph [0125]). The mere statement that an XML DTD is *made available* to others does not disclose the specific limitation of *a proxy service sending* a schema to a first entity, as recite in applicants' claim 138. There are, in fact, many ways in which information may be "made available" to entities in a distributed computing environment, as is well known in the art. For example, Tuatini states that the XML DTDs may be stored separately from the access interface information (Tuatini, paragraph [0128]) and that Tuatini's messaging component may *retrieve* the XML DTD to verify that a message is properly formatted, thus implying that in Tuatini's system the XML DTDs are made available by storing them in a shared location.

As anticipation under 35 U.S.C. § 102 requires that the presence in a single prior art reference disclosure of <u>each and every element</u> of the claimed invention, <u>arranged as in the claim</u> (*Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221

USPQ 481, 485 (Fed. Cir. 1984)), Tuatini clearly does not anticipate applicants' claim 138. Thus, the rejection of claim 138 is not supported by the prior art and removal thereof is respectfully requested.

**Furthermore, this rejection is improper because the Examiner has not shown that Tuatini qualifies as a prior art reference.** The Examiner has the burden of proof to produce the factual basis for the rejection. *In re Warner*, 154 USPQ 173, 177 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057 (1968). Since the Examiner has not proven that Tuatini qualifies as a prior art reference, the Examiner has not met this burden of proof and the rejection is improper. More specifically, the Tuatini patent was filed on January 2, 2001, <u>after</u> applicants' filing date of October 19, 2000. Tuatini does claim the benefit of provisional applications filed December 30, 1999. However, the December 30, 1999 filing date can only be used as Tuatini's 35 U.S.C. § 102(e) prior art date for the subject matter that is common to both the Tuatini patent and the provisional applications. Since it is common practice for a later filed utility application to include more or different subject matter than its earlier provisional application(s), it is unclear whether the material in Tuatini relied upon by the Examiner was actually present in Tuatini's provisional applications. In fact, from even a cursory review it is clear that Tuatini's published application differs greatly from its provisional applications.

Moreover, the Tuatini publication is not entitled to the December 30, 1999 date as a section 102(e) prior art date unless at least one claim of the Tuatini publication is supported (under 35 U.S.C. § 112) in the provisional application. Under 35 U.S.C. 119(e)(1), a published patent application is not entitled to its provisional application's filing date as a prior art date unless at least one claim of the published application is supported (per 35 U.S.C. § 112) in the provisional application. The rejection is improper unless the Examiner can show that Tuatini's published application has the necessary claim support in the provisional application to be entitled to the provisional application's filing date as its § 102(e) prior art date. *See also* M.P.E.P. § 2136.03(IV).

In response to Applicants' previous request that the Examiner particularly point out those portions of Tuatini's provisional application relied upon by the Examiner, as required by 37 CFR 1.104(c)(2), the Examiner refers to pages 4, 16, 78, 112, 236, 324, and 428 of Tuatini's provisional application 60/173,712. However, three of these pages (78, 112, 136) are portions of a general, high level, overview and do not support, or have any relevance to, the portions of Tuatini's publication that the Examiner is relying upon in his rejection. For example, page 78 is merely a title page that mentions "GEPS E-Business Architecture Workout" and "Java Coding Standards". Page 112 is an illustration depicting various categories, such as auditing, security, event logging, etc. illustrated as puzzle pieces with an "application component" puzzle piece in the center. Page 236 lists various developmental steps, such as "define and develop partitioning, replication and referral policies", "develop load, maintenance and synchronization services", "develop framework LDAP query components", etc. Nothing in these three pages supports the specific subject matter of Tuatini relied upon by the Examiner in his rejections.

Page 324 of Tuatini's provisional application 60/173,712 illustrates a flowchart. However, the details of the flowchart are completely illegible. If the Examiner is relying upon information depicted in the flowchart on page 324, applicants respectfully request that the Examiner provide a legible copy of page 324.

The Examiner also refers to pages 4, 16 and 428 of Tuatini's provisional application 60/173,712. Page 4 illustrates the logical connects between various components that collaborate with Tuatini's ControlServlet component. Page 16 describes various Java classes, such as the Application, BaseGenericServlet and BaseHttpServlet classes. Page 428 provides a discussion of Tuatini's messaging component and is the only page referred to by the Examiner that teaches something relied upon by the Examiner, namely Tuatini's messaging component. The pages referred to by the Examiner, whether considered individually or as a group, do not support hardly any of the subject matter of Tuatini relied upon by the Examiner in his rejection. Furthermore, the pages of the Tuatini provisional application cited by the Examiner do not support any

of the claims of Tuatini's application. For instance, the pages cited by the Examiner do not support claim 1 of the Tuatini application per the requirements of 35 U.S.C. § 112, first paragraph. Therefore, the Examiner has not met his burden of proof to show that Tuatini qualifies as prior art.

## Section 103(a) Rejection:

The Examiner rejected claims 1-5, 19-21, 23, 24, 51-55, 68-70, 72, 73, 100-103, 113, 114, 116 and 117 under 35 U.S.C. § 103(a) as being unpatentable over Tuatini in view of Mead et al. (U.S. Patent 6,061,728) (hereinafter "Mead"), claim 136 as being unpatentable over Tuatini in view of Cheng (U.S. Publication 2001/0032273), Machin et al. (U.S. Publication 2002/0032806) (hereinafter "Machin") and Beck et al. (U.S. Patent 6,604,140) (hereinafter "Beck"), claims 6, 7, 56, 57, 104 and 105 as being unpatentable over Tuatini, Mead and Cheng in view of Beck, claims 8-18, 58-67 and 106-112 as being unpatentable over Tuatini, Mead, Cheng and Beck in view of Machin, and claims 22, 71 and 115 as being unpatentable over Tuatini in view of AAPA (page 2-6 of specification). Applicants respectfully traverse these rejections for at least the following reasons.

Regarding claim 1, Tuatini in view of Mead fails to teach or suggest a proxy service providing to the first entity an interface to a second entity in the second computing environment, <u>wherein the proxy service appears to the first entity as the second entity</u>. The Examiner admits that Tuatini fails to each a proxy service that provides an interface to a second entity and that appears to a first entity as the second entity and relies upon Mead, citing column 3, lines 1 through column 4, line 24 of Mead. Mead teaches a system in which multiple proxy devices coordinate to communicate messages between local area networks via a wide area network using a transparent bridging system. Specifically, Mead teaches the use of a master proxy device that mediates and selects which of the proxy devices should handle which messages sent between a local area network and a wide area network.

The Examiner's assertion that Mead teaches the use of a proxy service that appears to a first entity as a second entity is clearly erroneous. Mead's proxy devices do not appear as other entities to Mead's clients (or to any other entity in Mead's system). Nowhere does Mead mention that his proxy devices appear as other entities to components of Mead's system. Instead, Mead's proxy devices route messages received from an end station between two local area networks via a wide area network. Each proxy device routes messages and translates them between an Ethernet protocol and a TCP/IP protocol (Mead, FIG. 3 and column 6, lines 28-60). Mead does not mention that a proxy device appears to the end station as the entity to which the end station is sending a message, as would be required if Mead were to teach a proxy service that appears to a first entity as a second entity, as the Examiner contends. The Examiner is apparently relying upon the fact that Mead's system includes a transparent bridging mechanism. However, transparent bridging is well understood in the art and **does not include** a proxy service that provides an interface to a second entity and that *appears as the second entity to a first entity*. Mead's proxy devices are transparent because an entity on one local area network sending a message to another local area network via a wide area network is not aware that the proxy devices are performing the routing. Instead, as noted above, Mead's proxy devices only route network message frames from one network to another. The end stations in Mead's system are not aware of Mead's proxy devices at all and do not view the proxy devices as some other entity in the computing environment.

Additionally, the Examiner's proposed combination of Tuatini and Mead would not result in a system that includes a proxy service providing to a first entity an interface to a second entity where the proxy service appears to the first entity as the second entity. Instead, the Examiner's proposed combination of Tuatini and Mead would result only in allowing Tuatini's application framework, including the messaging component to also transparently route messages between local area networks via a wide area networks using the multiple proxy devices of Mead. Since neither Tuatini nor Mead, whether considered single or in combination, teaches or suggests a proxy service that appears as another entity, no combination of Tuatini and Mead would include such a proxy service (that appears as another entity).

Moreover, Mead's proxy devices are at a completely different computing layer than Tuatini's messaging component, which the Examiner interprets as the proxy service of Applicants' claim. Tuatini's messaging component does not have anything to do with routing frames between a LAN and a WAN. Even if one where to modify the messaging component of Tuatini, which the Examiner interprets as a proxy service providing to first entity an interface to a second entity, the result would merely allow Tuatini's messaging component to route messages between a local area network and a wide area network and between an Ethernet protocol and a TCP/IP protocol. Nothing in such a combination would include or suggest that the messaging component would appear as another entity.

Therefore, for at least the reasons presented above, the rejection of claim 1 is not supported by the prior art and removal thereof is respectfully requested. Similar remarks also apply to claims 51 and 100.

Regarding claim 8, contrary to the Examiner's assertion, Tuatini in view of Mead, Cheng, Beck, and Machin fails to teach or suggest that the advertisement includes information describing one or more computer programming language method calls to methods in the computer programming language provided by the second entity, and the cited references further fail to teach or suggest constructing on the first entity a client method gate configured to provide an interface to the second entity by generating data representation language messages including information representing the method calls.

The Examiner relies upon Cheng to teach information describing one or more computing programming language method calls to methods in the computer programming language of a second entity, citing paragraphs 10-12 of Cheng. Cheng teaches the use of thin glue layers to bridge a non-IP network with the Internet. The passages cited by the Examiner describe that Cheng's thin glue layers translate between the IP protocol and the non-IP protocol and allow commands and responses to tunnel between applications in the Internet and the non-IP network (Cheng, paragraph [0011]). The Examiner seems to be arguing that Cheng's teaching regarding a HAVi (a particular

non-IP network) application using a HAVi API to access Internet services implies providing information describing computer programming method calls. However, Cheng does not mention providing any sort of information describing computer programming language method calls. Instead, Cheng only refers to the fact that thin glue layers can translate between the two protocols (non-IP and IP based protocols). None of Tuatini, Mead, Beck, Cheng, or Machin, alone or in combination, teach or suggest providing information describing computer programming language method calls, let alone generating data representation language messages including information representing the method calls.

For at least the reasons given above, the rejection of claim 8 is not supported by the cited prior art and removal thereof is respectfully requested. Remarks similar to those above regarding claim 8 also apply to claims 57 and 106.

Regarding claim 9, contrary to the Examiner's assertion, Tuatini in view of Mead, Cheng, Beck and Machin fails to teach or suggest the first entity generating a method call in the computer programming language; the <u>client method gate generating a data representation language message</u> including information representing the method call; the client method gate sending the data representation language message to a proxy method gate comprised on the proxy service. The Examiner relies upon Machin to teach a client method gate generating a data representation language message including information representing a method call generated by a first entity and cites paragraphs 136 – 138 of Machin. The cited portions of Machin describe Machin's proxy client component that exposes the functionality of an I/O subsystem as TAPI line devices (paragraphs 130 and 136). However, nowhere does Machin mention that the proxy client component, which the Examiner interprets as a client method gate, sends messages in a data representation language as the Examiner contends. Instead, Machin teaches that the proxy client allows data to be exchanged between an application that uses TAPI commands and an I/O subsystem that doesn't use TAPI commands. Nowhere does Machin mention that the proxy client component communicates with the I/O subsystem using a data representation language message. The Examiner is merely speculating that Machin's proxy client

component generates a data representation language message without citing any portion of Machin that actually teaches or describes the use of data representation language messages.

Tuatini, Mead, Cheng, and Beck are not relied upon by the Examiner to teach, nor do they teach or suggest, a client method gate generating a data representation language message including information representing a method call. Thus, Tuatini, Mead, Cheng, and Beck fail to overcome the above noted deficiency of Machin. Therefore, the Examiner's proposed combination of Tuatini, Mead, Cheng, Beck and Machin also fails to teach or suggest a client method gate generating a data representation language message including information representing a method call.

Thus, for at least the reasons given above, the rejection of claim 9 is not supported by the prior art and its removal is respectfully requested. Remarks similar to those above regarding claim 9 also apply to claims 58 and 107.

Regarding claim 11, Tuatini in view of Mead, Cheng, Beck and Machin fails to teach or suggest a proxy service <u>generating a results advertisement</u> for the results data; the proxy service <u>sending the result advertisement to the client method gate</u>; and the first entity <u>generating a results method gate from the results advertisement</u> sent to the client method gate, contrary to the Examiner's contention.

The Examiner has failed to cite any portion of Tuatini, Mead, Cheng, Beck or Machin that teaches or suggests a proxy service generating a results advertisement for results data. Nor do Tuatini, Mead, Cheng, Beck or Machin, whether considered singly or in combination, teach or suggest generating a results advertisement for results data. The Examiner cites paragraph 65 of Tuatini as teaching "usage of generating result data/information" but does not provide any interpretation, argument or citation that teaches or suggests *generating a results advertisement* for results data. Thus, the rejection of claim 11 is improper.

Additionally, the Examiner argues that Machin teaches "sending the result information to a client method gate", citing paragraphs 136 – 138 of Machin. However, claim 11 does not recite "sending result information to a client method gate." Instead, claim 11 recites, in part, "the proxy service sending the results *advertisement* to the client method gate" (emphasis added). Nowhere does Machin (or Tuatini, Mead, Cheng, or Beck) teach or suggest a proxy service sending the results advertisement to a client method gate. Machin fails to mention anything at all about a results advertisement. Furthermore, since Tuatini, Mead, Cheng, and Beck also fail to teach or suggest sending results advertisement to a client method gate, the Examiner's combination of Tuatini, Mead, Cheng, Beck and Machin also fails to include a proxy service sending a results advertisement to a client method gate.

Furthermore, the Examiner also contends that Machin teaches generating a results method gate from the results advertisement sent to the client method gate and cites paragraphs 114-116 of Machin. The cited portion of Machin describes establishing a virtual connection between a client and an integrating component. However, the cited passage does not mention generating a results method gate, nor does the Examiner point out any portion of Machin's system that the Examiner interprets as a results method gate. The cited portion of Machin merely describes how after the virtual connect is established the connection characteristics are used to determine which client should receive the connection. Nowhere does Machin teach or suggest generating a results method gate from a results advertisement sent to Machin's proxy client component, which the Examiner interprets as a client method gate. Since Tuatini, Mead, Cheng, and Beck also fail to teach or suggest generating a results method gate from a results advertisement, The Examiner's combination of Tuatini, Mead, Cheng, Beck and Machin also fails to teach or suggest generating a results method gate from a results advertisement sent to a client method gate.

In response to Applicants previously presented arguments regarding claim 11, the Examiner contends, in the Response to Arguments, that Applicants argued against the references (then Tuatini in view of Beck) individually. However, Applicants very clearly

argued what was suggested by the combination of the references. For example, applicants have argued with reference to Tuatini <u>in view of</u> Beck and specifically refer to the fact that "Tuatini and Beck, either separately or in any combination" fail to teach certain limitations of applicants' claims. Applicants' also argued previously that "the Examiner's suggested combination of Tuatini and Beck does not result in a system that includes generating results advertisement, sending such a results advertisement to a client method gate or generating a results method gate from the results advertisement."

Furthermore, to the extent that Applicants presented arguments regarding a single cited reference, those arguments were demonstrating that, for the specific subject matter relied upon by the Examiner, the Examiner's reliance on that cited reference was erroneous. Applicants respectfully traverse the Examiner contention that applicants have only argued against the references individually.

Thus, for at least the reasons given above, the rejection of claim 11 is not supported by the prior art and its removal is respectfully requested. Remarks similar to those above regarding claim 8 also apply to claims 60 and 108.

Regarding claim 22, the Examiner stated that it would have been obvious to combine the teachings of Tuatini and the AAPA because the AAPA's use of Jini environment would provide access to the Jini services. Applicants disagree with the Examiner's statement. Applicants submit that such a broad conclusory statement, as made by the Examiner, does not provide a sufficient motivation to combine the teachings Tuatini and the AAPA. "The factual inquiry whether to combine references must be thorough and searching." *McGinley v. Franklin Sports, Inc.*, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). It must be based on objective evidence of record. "This precedent has been reinforced in myriad decisions, and cannot be dispensed with." *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). "A showing of a suggestion, teaching, or motivation to combine the prior art references is an essential component of an obviousness holding." *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000).

The Federal Circuit has stated: "[o]ur case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." The need for specificity pervades this authority. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed" (emphasis added)); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the [Examiner] must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the [Examiner] must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *See also, In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

The Examiner has failed to provide any proper motivation for modifying Tuatini in view of AAPA. Instead the Examiner has merely pointed to standard boilerplate indicating that Tuatini's system may be modified, but that does not provide any motivation for the specify modification suggested by the Examiner. Similarly, nothing from AAPA provides any suggestion to modify the teaching of Tuatini to include the Jini environment.

Just because the Jini environment was known in the prior art, does not mean that one of ordinary skill in the art would have been motivated to modify the teachings of Tuatini with the Jini environment. The Examiner has provided no objective evidence of record to the contrary. Applicants also respectfully remind the Examiner that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." (M.P.E.P. § 2143.01, paragraph 8). The Examiner has only shown that both Tuatini and the Jini environment were known in the art. However, the Examiner's

stated motivation, namely, "to utilize Jini services of the Jini environment so that a client will be able to acess [sic] advertisement related information from the remote servers of the Jini network through proxy services" amounts to nothing more than a conclusory statement based in hind-sight analysis of the present application.

In the Response to Arguments, the Examiner notes that the test for obviousness to combine references is not whether the features of a secondary references may be bodily incorporated into the structure of a primary references and is also not that the claimed invention must be expressly suggested in any one or all of the references. Rather the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. However applicants are arguing that no one would be motivated to modify the system of Tuatini to include the Jini environment in view both the Tuatini reference and applicants' AAPA. Furthermore, this statement by the Examiner does not change the fact that the Examiner has failed to provide a proper motivation to modify Tuatini in view of applicants' AAPA. As noted above, the Examiner has merely referred to features of the Jini environment, such as "[t]he Jini environment would provide access to Jini services", "Jini services would provide information to the client over the network" and "[t]he client would utilize the provided information". Thus, the Examiner's stated motivation amounts to nothing more than concluding that since both Tuatini's system and the Jini environment were known it would be obvious to combine them, which as noted above, is clearly improper.

In light of the above remarks, Applicants assert that the rejection of claim 22 is not supported any evidence of record. Withdrawal of the rejection is respectfully requested. Similar remarks as discussed above in regard to claim 22 apply to claims 71 and 115.

Regarding claim 136, Tuatini in view of Cheng, Machin and Beck fails to teach or suggest a proxy service providing to the first entity an interface to a second entity in the second computing environment comprises providing an advertisement for the second entity, wherein the advertisement for the second entity includes access information for

accessing the second entity in the second environment from the first environment and wherein the advertisement includes information describing one or more computer programming language method calls to methods in the computer programming language provided by the second entity.

The Examiner relies upon Cheng to teach providing an advertisement for the second entity including access information for accessing the second entity and including information describing computer programming language method calls to methods in the computer programming language provided by the second entity. The Examiner cites figure 3 and paragraphs 9-12 and 23-24 of Cheng. However, the cited portions of Cheng do not describe providing an advertisement including access information and information describing computer programming method calls. Instead, as noted above, Cheng teaches the use of thin glue layers to bridge a non-IP network with the Internet. Cheng's thin glue layers translate between the IP protocol and the non-IP protocol and allow commands and responses to tunnel between applications in the Internet and the non-IP network (Cheng, paragraph [0011]).

The Examiner seems to be arguing that Cheng teaching regarding a HAVi (a particular non-IP network) application can using a HAVi API to access Internet services implies providing an advertisement including access information and describing method calls. However, Cheng does not mention providing any sort of advertisement that includes access information or describing computer programming language method calls. Instead, Cheng only refers to the fact that the glue layers can translate between the two protocols. The Examiner admits that Tuatini fails to provide an advertisement including access information and describing computer programming language method calls. Thus, the Examiner proposed combination of Tuatini and Cheng also fails to teach providing an advertisement including access information and describing computer programming language method calls. Furthermore, Machin and Beck fail to overcome the above noted deficiencies of both Tuatini and Cheng. Therefore, the combination of Tuatini, Cheng, Machin and Beck fails to teach or suggest a proxy service providing an advertisement including access information and describing method calls.

In response to Applicants previously presented arguments regarding claim 136, the Examiner, in the Response to Arguments, contends that Applicants argued against the references (then Tuatini in view of Beck) individually. However, Applicants very clearly argued against the references both individually and in combination. For example, applicants have argued with reference to Tuatini in view of Beck and specifically refer to the fact that "Tuatini and Beck, either separately or in any combination" fail to teach certain limitations of applicants' claims. Applicants' previously presented argument concluded by stating, "the Examiner's suggested combination of Tuatini and Beck fails to teach or suggest" various limitations of Applicants' claims. Furthermore, to the extent that Applicants have presented arguments regarding a single cited reference, those arguments were demonstrating that, for the specific subject matter relied upon by the Examiner, the Examiner's reliance on that cited reference was erroneous. Thus, applicants respectfully traverse the Examiner contention that applicants have only argued against the references individually.

Thus, for at least the reasons above, the rejection of claim 136 is not supported by the prior art and removal thereof is respectfully requested.

Applicants also assert that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the rejection has been shown to be unsupported for the independent claims, a further discussion of the dependent claims is not necessary at this time.

**Information Disclosure Statements:**

The Examiner states that the references originally submitted with applicants' IDS on August 16, 2001 are not available in the application of record. The Examiner also states that applicants' IDS dated April 29, 2005 did not include the cited references. While applicants maintain that both sets of references were in fact originally submitted, as evidenced by the respective date-stamped return postcards from the original IDS

submissions, applicants are re-submitting these references for the convenience of the Examiner.
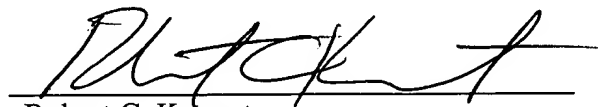
## CONCLUSION

Applicants submit the application is in condition for allowance, and notice to that effect is respectfully requested.

If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above referenced application from becoming abandoned, applicants hereby petition for such an extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5181-72200/RCK.

Also enclosed herewith are the following items:

☒ Return Receipt Postcard

☐ Petition for Extension of Time

☐ Notice of Change of Address

☒ Copies of references from IDS of August 16, 2001 and from IDS of April 29, 2005

Respectfully submitted,

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Reg. No. 39,255
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Date: ___October 11, 2005___